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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CA Think, Inc.

Serial No. 75/046,395

Frederic M. Wilf of Saul Ewing Remick & Saul for CA Think, Inc.

Stanley I. Osborne, Jr., Trademark Examining Attorney, Law
Office 102 (Thomas Shaw, Managing Attorney).

Before Hairston, Bucher and Bottorff, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

CA Think, Inc., a Delaware corporation, has filed an
application¹ for registration of the mark "PROFESSIONAL HELP
DESK" for "computer software and instructional manuals, sold
together as a unit, for the management, tracking and resolution
of support inquiries and requests for help regarding computer
technical issues."²

¹ The trademark application was actually filed by International
Data Operations, Inc., in 1996. However, during the prosecution of
this appeal, on April 10, 1998, the mark was assigned to CA Think,
Inc.

² Serial No. 75/046,395, filed January 22, 1996, alleging use since
January 1, 1994.

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark "PROFESSIONAL HELP DESK" when used on this software, so resembles the registered mark, "HELPDESK," as applied to "computer programs for linking work stations to provide in-house, end-user support" as to be likely to cause confusion, or to cause mistake, or to deceive.³ The Trademark Examining Attorney also issued a final refusal to register based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's entire mark is merely descriptive of the goods.

Applicant has appealed both bases of the final refusal to register. Briefs have been filed,⁴ but applicant did not request an oral hearing.

First, we will focus on the issue of likelihood of confusion with the cited Trellis registration. The Trademark Examining Attorney contends that the mere addition of a word to a registered mark is not sufficient to overcome a likelihood of

³ Registration No. 1,548,090 issued on July 18, 1989 to Trellis Software, Inc. The registration (hereinafter, the "Trellis registration") sets forth dates of first use of September 30, 1988; §8 affidavit accepted and §15 affidavit filed.

⁴ The Trademark Examining Attorney in his brief, and the applicant with its reply brief, have continued to submit attachments as evidence of their respective positions. We have not considered either group of attachments since they do not comply with the established rule that the evidentiary record in an application must be complete prior to the filing of the notice of appeal. See 37 CFR 2.142(d), and In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994).

confusion when the marks have such similar connotations. He points out that the goods of applicant and registrant are substantially identical.

Applicant argues strenuously that the Trellis registration should not stand as a bar to the instant application because the term "Help Desk" is highly descriptive of this type of computer programs. Applicant contends that the cited registration is not enforceable, or if it is enforceable at all, it would be as a single word ("HELPDESK") and not as two separate words as applicant seeks to register it ("HELP DESK"). Applicant also points out that third-party registrations on the federal register demonstrate the inconsistency of the position taken by the Trademark Examining Attorney.⁵ Applicant argues that third parties' composite marks incorporating the word "HELP DESK" (or "HELPDESK") have registered in recent years despite the existence of the Trellis registration. These third parties were permitted to disclaim "HELP DESK" or "HELPDESK." Furthermore, applicant contends that the word "PROFESSIONAL" -- the prominent first word in its mark -- is alone distinctive enough to serve

⁵ Applicant lists a small number of third-party registrations in responses to Office actions and again in its briefs. However, in reaching our decision, the Board is not compelled to even consider the listed registrations as credible evidence of the existence of the registrations so listed. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). In order to make these third party registrations of record during *ex parte* examination, soft copies of the registrations or even photocopies of the appropriate U.S. Patent and Trademark

as a source-identifier for goods in this field, and cites to specific third-party registrations to demonstrate this point.⁶

In the course of rendering this decision, we have followed the guidance of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), that sets forth the factors which, if relevant, should be considered in determining likelihood of confusion.

We turn first to a closer examination of the goods of registrant and of applicant. Registrant's goods are described as "computer programs for linking work stations to provide in-house, end-user support." Applicant has identified its goods as "computer software and instructional manuals, sold together as a unit, for the management, tracking and resolution of support inquiries and requests for help regarding computer technical issues." Both are goods in International Class 9, namely, computer "programs" or computer "software." Both listings describe software applications being used in a computer-networking environment. While using different wording, it is clear both computer programs would be marketed to large organizations that want to provide in-house technical assistance more efficiently for their employees -- specifically, computer

Office electronic printouts must be submitted. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992).

⁶ As noted above, these third-party registrations are not properly of record in this case.

end-users experiencing difficulties. Accordingly, looking at the two identifications of goods, we agree with the Trademark Examining Attorney that under trademark law, these goods must be deemed to be substantially the same.

We turn next to a critical examination of the marks. It appears that applicant has taken registrant's mark, "HELPDESK," has altered it slightly by inserting a space between the word "HELP" and the word "DESK," and then has incorporated it into its own mark by adding the word "PROFESSIONAL." We find that this new mark does not create a starkly different commercial impression from that one takes away from the Trellis mark. For example, customers of registrant's "HELPDESK" software may well assume that applicant's "PROFESSIONAL HELP DESK"⁷ software is a new release or an updated version of the "HELPDESK" software.

Applicant has repeatedly taken the position -- during the prosecution of this application before the Trademark Examining Operations and again during this *ex parte* appeal before the Board -- that the Trellis registration is unenforceable because the term "help desk" (or "help-desk" or "helpdesk") is highly descriptive in this field. However, Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate

⁷ We should also note that while applicant's drawing does indeed show the mark as "... HELP DESK" (two words), the predominant commercial impression one takes away from applicant's actual usage of this mark on the specimens of record is of a single word "... HELPDESK."

of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate.

Accordingly, during this *ex parte* prosecution, applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., that the mark is unenforceable because it is merely descriptive or even generic). See *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (CCPA 1970); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB 1988).

In any event, notwithstanding any alleged weakness in the cited mark, even weak marks are entitled to protection against the registration by a subsequent user of a substantially similar mark for closely related goods.

Turning to the issue of descriptiveness, we examine the evidence placed into the record by the Trademark Examining Attorney. The initial LEXIS/NEXIS search for the phrase "professional help desk" resulted in fifty-two stories, of which only the first twenty-five were attached to the initial Office action. Of these stories, at least twenty-two reflect proper trademark usage of the term, referring to applicant and/or its

software products. Viewed in a light most favorable to the Office, only one reporter/writer used the term "professional help desk" in an arguably descriptive manner. Similarly, the evidence of record later placed into the file (i.e., up through the time of the final refusal to register) did not do anything to strengthen his conclusion that this entire phrase is merely descriptive.

The Trademark Examining Attorney also attached to the initial Office action three separate dictionary entries defining the words "professional," "help," and "desk." He then argues that taking the ordinary meaning of each of these entries singly and putting them into a composite phrase, the resulting meaning is merely descriptive of the goods. However, we find neither the explanations consistent nor the evidence convincing.

There is no evidence in the record, for example, to show that "professional" is used in the industry to describe a broad class of software. Additionally, at various times in the *ex parte* prosecution of this application, the Trademark Examining Attorney attempts to explain why the word "Professional" is descriptive in the context of this composite mark. However, in looking at the evidence, none of the cited uses conveys an immediate or precise significance with respect to applicant's software. See U.S. West Inc. v. BellSouth Corp., 18 USPQ2d 1307, 1312 (TTAB 1990) ["THE REAL YELLOW PAGES" is not merely

descriptive of classified telephone directory since word "REAL" does not "...convey any immediate or precise significance with respect to applicant's goods..."].

We find that the word "Professional" does not convey an immediate significance as to specific members of a corporate call center's staff (e.g., analysts, programmers, administrators and/or managers). The word "Professional" does not convey an immediate significance as to the actual computer end-users within the corporate customer's organization. And it does not convey anything precise as to a feature of the goods themselves - i.e., the advanced capabilities of the software itself to supplant call center support personnel altogether. When this lack of immediacy and precision on the part of the word "Professional" alone is combined with the evidence of uses of this combined term (e.g., in periodicals, whenever the three word term "Professional Help Desk" appears, it refers overwhelmingly to applicant and/or applicant's products), it casts doubt on the Office's conclusion. Accordingly, based solely upon the record we have before us, we harbor doubt about whether this term is merely descriptive. It has long been recognized that there is a thin line separating highly suggestive and merely descriptive designations. In a case where reasonable persons may differ, it has been the practice of this Board to resolve such doubt in applicant's favor and publish the

mark for opposition purposes (unless, of course, like the instant case, the alleged descriptiveness issue is not the sole impediment in the case). Accordingly, we reverse the refusal to register on the basis of mere descriptiveness.

Decision: The refusal to register based upon likelihood of confusion is affirmed. The refusal to register based upon mere descriptiveness is reversed.

P. T. Hairston

D. E. Bucher

C. M. Bottorff
Administrative Trademark Judges,
Trademark Trial and Appeal Board